

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

NAKAI et al.

Serial No. 09/833,651

Filed: April 13, 2001

For: PRINT CONTROL OPERATION SYSTEM USING ICONS



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Examiner: Pillai, Namitha

November 6, 2008

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the Examiner.

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(I) **REAL PARTY IN INTEREST**

The real party in interest is Sharp Kabushiki Kaisha, a corporation of the country of Japan.

(II) RELATED APPEALS AND INTERFERENCES

The appellant, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claims 1-11 are pending. Claims 1-8 and 10-11 have been rejected. Claim 9 has been allowed. Thus, claims 1-8 and 10-11 are on appeal herein.

(IV) STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

This section is for purposes of example only and without limitation.

Claim 1 relates to a print control operation system. In certain example embodiments, the print control operation system of claim 1 uses icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed (e.g., pg. 4, lines 5-8 and 21), print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping the file icon on the print icon (e.g., pg. 4, lines 8-11; pg. 17, lines 21-23; pg. 9, line 24 to pg. 11, line 2; Figs. 1A-1B). In certain example embodiments, the print icon is formed so that the display is altered according to a setting of the print conditions in the print icon (e.g., pg. 11, lines 5-24; pg. 12, line 13 to pg. 13, line 17), and the print conditions are displayed on the display picture in a recognizable display form when the file icon is not located over the print icon (e.g., page 11, lines 6-24; pg. 4, lines 11-13; pg. 17, lines 17-21; and Fig. 2). The print icon to which the file icon is dragged and dropped is an icon which limits on a specific function among print processing functions provided in a corresponding printer (e.g., pg. 5, line 13 to pg. 6, line 9; pg. 7, lines 15-25; pg. 11, lines 9-24;), and which issues a print command by a function which specifies the file icon for the printer when the file icon is dragged and dropped on the print icon. In certain example embodiments, the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer (e.g., pg. 6, lines 10-25; pg. 12, lines 1-25; pg. 15, lines 5-13; and pg. 17, lines 21-23).

Claim 3 relates to a print control operation system. The print control operation system uses icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed (e.g., pg. 4, lines 5-8 and 21). In certain example embodiments, print processing of the file being executed under the predetermined print

conditions is performed by at least dragging the file icon and dropping it on the print icon (e.g., pg. 4, lines 8-11; pg. 17, lines 21-23; pg. 9, line 24 to pg. 11, line 2; Figs. 1A-1B). In certain example embodiments, the print conditions in the print icon are displayed on the display picture in a recognizable display form (e.g., page 11, lines 6-24; pg. 4, lines 11-13; pg. 17, lines 17-21; Fig. 2). At a time point when a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon's associated file to be printed is displayed on the display picture (e.g., pg. 4, lines 21-25; pg. 18, lines 9-15; and Figs. 7, 11). As shown in Figs. 7 and 11 for example, a "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed. This is advantageous, for example, in that it permits a user to view and confirm contents of a file to be printed without having to open the file on an application (e.g., pg. 18, lines 12-15).

Claim 8 requires "a printer to be used is set in said print icon as one of set conditions of said print icon, a state of said printer is monitored in said print control operation system, and *when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.*" For example, see the instant specification at page 19, line 19 to page 20, line 1. See also page 16, lines 5-15. For example, it is explained on page 16 of the instant specification that "[i]n this case, however, the state of a printer set in each print icon is confirmed, and a print icon of a printer that cannot conduct processing is prevented from being displayed. For example, if staple processing is set in a print icon and the set printer staple runs out, then the print icon is not displayed. Also in the case where the power supply of a set printer is not on, the print icon is not displayed. Or it is also possible to conduct gray-out display of a print icon that cannot be processed and explicitly indicate that the function is inhibited."

(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(i) Whether claims 1, 2 and 10 are unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527) in view of Hemenway (US 5,638,505).

(ii) Whether claims 3, 5-8 and 11 are unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527) in view of Rzepkowski et al. (US 7,065,716).

(iii) Whether claim 4 is unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527) in view of Rzepkowski et al. (US 7,065,716) and Hemenway (US 5,638,505).

(VII) ARGUMENT

It is axiomatic that in order for a reference to anticipate a claim, it must disclose, teach or suggest each and every feature recited in the claim. See, e.g., *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). The USPTO has the burden in this respect.

Moreover, the USPTO has the burden under 35 U.S.C. Section 103 of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745, F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing that some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Before the USPTO may combine the disclosures of the references in order to establish a *prima facie* case of obviousness, there must be some suggestion for doing so. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). Even assuming, *arguendo*, that a given combination of references is proper, the combination of references must in any event disclose the features of the claimed invention in order to render it obvious.

Furthermore, with respect to the inherency rejections, the law is clear that for something to be “inherent” in a reference, it must “necessarily” be present. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The fact that a certain result or characteristic “may” occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Board of Appeals has made clear that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

(i) Whether claims 1, 2 and 10 are unpatentable under Section 103(a) over Fitzpatrick in
view of Hemenway

Claim 1 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Fitzpatrick in view of Hemenway. This Section 103(a) rejection is respectfully traversed and should be reversed for at least the following reasons.

The Examiner acknowledged that Fitzpatrick teaches all the limitations of claim 1 except the limitation that “print conditions are displayed on said display picture in a recognizable display form when the file icon is not located over the print icon”. He then resorted to Hemenway for the missing limitation.

Fitzpatrick generally discloses a technique for sending a printing command to a printer for printing a file, by dropping a dragged file icon 29 onto a print icon 23A (Fig. 2).

Furthermore, when the file icon is superposed on the print icon for a predetermined amount of time (Fig. 3), a window picture for parameter setting different from default setting is displayed (Fig. 4) so that it is possible to identify/set the printing conditions.

First, claim 1 requires “a print icon having predetermined print conditions...executed under the predetermined print conditions in said print icon...a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer.” Fitzpatrick (and Hemenway) fails to disclose this feature. As discussed above, in certain example embodiments of the invention, the print icon has a display of print conditions on the icon itself. No additional operation needs to be performed for the user to view the predetermined printing conditions in the print icon. For example, by seeing the print icon corresponding to management number 2 in Fig. 8 of the present application, the user knows that the printer is set to print 2 copies in a 2-up output format.

In contrast, in both Fitzpatrick and Hemenway, the icon itself lacks any printing information that is present on the icon. In Fitzpatrick, the user must hover the dragged file icon

over the print icon for a certain time until a dialog box containing printing information opens up (Fig. 4). The print icon 23A itself lacks any printing information (see Figs. 2-3). Similarly, in Hemenway, the print icon itself (see icon labeled “PrintTool” on the display screen) lacks any printing information. Only by clicking on the icon a display window 46 opens up containing printing information.

In other words, the example embodiment of the invention presented in the present application features a print short-cut icon, which is a combination of print processing functions selected in advance from functions carried by the printer. This feature lacks in Fitzpatrick and Hemenway, where the “functional icon” is merely an object for dragging and dropping the file icon. As to subsequent operation for how to process the data meant for the file icon which is dragged and dropped, it is so configured to be set up by opening a new window.

The Examiner argued that the limitation “the print conditions are not displayed on the print icons” has not been clearly disclosed in the present claims. It is submitted that the claim language recites “a print icon having predetermined print conditions”, which implies that the print icon contains the predetermined print conditions. The Examiner’s interpretation is consistent with claim language citing “a print icon associated with predetermined print conditions”, which is different than the actual claim language.

Second, claim 1 also requires “the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer”. Fitzpatrick (and Hemenway) fails to teach or suggest this feature. In an example embodiment of the invention, the user can create a new print icon with desired printing conditions (see lines 16-21, p. 16, Fig. 9). In contrast, in Fitzpatrick the icon is apparently prepared by the vendor who provided the print system, and the user cannot create new print icons (other than temporarily change the default settings of the provided print icon).

The Examiner argued that “[t]he print icon that includes the default parameters are generated for display to the user in Fitzpatrick”. It is submitted that in Fitzpatrick a print icon cannot be generated. Instead, print icons are pre-existing, prepared by the vendor who provided the print system.

Regarding the missing limitation of “said print conditions are displayed on said display picture in a recognizable display form when the file icon is not located over the print icon”, allegedly taught by Hemenway, it is respectfully submitted that Hemenway fails to teach said limitation. Hemenway discloses that the print conditions are displayed on a different window, e.g. 46, than the print icon, e.g., “PrintTool”, that is on the display screen. Said window does not open unless the additional operation of double clicking on the print icon is performed. Hence, one of ordinary skill in the art at the time the invention was made would not have looked into Hemenway for modifying the system of Fitzpatrick so that the print icon displays printing information when the file icon is not in contact, since in Hemenway the icon does not display any information without any additional operation, in addition to Hemenway not teaching a drag operation.

The Examiner argued that “[t]he well known method for accessing print conditions where a print icon is directly accessed reads on accessing and displaying print conditions when the file is not located over the print icon”. Hemenway is unrelated to dragging (or not) a file icon over a print icon. Hence, the fact that print conditions can be accessed by an operation from the user does not read on “said print conditions are displayed on said display picture in a recognizable display form when the file icon is not located over the print icon”.

(ii) Whether claims 3, 5-8 and 11 are unpatentable under §103(a) over Fitzpatrick in view
of Rzepkowski

Claim 3 stands rejected under Section 103(a) as being allegedly unpatentable over Fitzpatrick in view of Rzepkowski. This Section 103(a) rejection is incorrect and should be reversed for at least the following reasons.

The Examiner acknowledged that Fitzpatrick teaches all the limitations of claim 3 except the limitation that “wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon’s associated file to be printed is displayed on said display picture.” He then resorted to Rzepkowski for the missing limitation.

First, claim 3 requires “a print icon having predetermined print conditions... wherein the print conditions in said print icon are displayed on said display picture in a recognizable display form...” Fitzpatrick fails to disclose this feature. As discussed above, the icons that are present on the display screen in Fitzpatrick’s system lack any printing information related to the associated printer, see for example, Figs. 2 and 3, where the print icon is a blank icon. Only after the user performs the hovering operation by superimposing the file icon on the print icon a separate window containing printing information appears (Fig. 4). In contrast, as discussed above, in certain example embodiments of the invention, the print icon has a display of print conditions on the icon itself (Fig. 8). No additional operation needs to be performed for the user to view the predetermined printing conditions in the print icon.

Regarding the missing limitation of “wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon’s associated file to be printed is displayed on said display picture”, allegedly taught by Rzepkowski, it is respectfully submitted that Rzepkowski fails to teach said limitation.

Rzepkowski is concerned with a completely different application compared to selecting and printing text files. Rzepkowski’s method allows a user to visualize the results of generating

a production scan of an original document using the current scan parameters without generating a preview scan (lines 23-27, col. 2). In other words, instead of actually performing a scan operation of an original document and accordingly judge whether the resulting captured image is desirable, i.e., with the desired frame, and scaling properties, the user views a preview pane portion that graphically illustrates how the various image capture parameters selected by the user will be applied to the original document to generate the captured electronic image data (lines 52-62, col. 2). For example, a preview mimic 482 (Fig. 6) may include: an image orientation mimic 488 that indicates the image orientation that will result based on the selected parameters; an image quality profile mimic 489 indicating, for example, that a “photo” image quality profile has been selected; page size mimic portion 483; crop/frame marquee 484; and a scale marquee 486 (lines 27-60, col. 12, lines 12-32, col. 13). Hence, the information appearing on the preview pane 480 includes various graphical symbols indicating the parameters of the scanned document. The information displayed on the preview panel does not include “a printing preview of the file icon’s associated file”, as required by claim 3.

In contrast, in an example embodiment of the present invention, a “printing preview”, as called for in claim 3, is an image of at least part of what is going to be printed (see, for example, Figs. 7 and 11). Rzepkowski does not show such a printing preview of the file to be scanned. All that is shown is various graphical schematic symbols helping the user visualize the size, and orientation of the document to be scanned (see, for example, Fig. 6 where no information about the actual contents of the document is revealed). There is nothing in Rzepkowski that even suggests this aspect of claim 3.

The Examiner argued that “[t]he preview pane displays how these parameters will look when applied to the document. Therefore, an image of the document is displayed in the print preview”. It is respectfully submitted that schematic display of various parameters is different than “the file icon’s associated file to be printed”, which is displayed on the display picture, as

required by claim 3. Nothing in Fig. 6 of Rzepkowski, and more specifically in the preview mimic 482, shows a preview of the file to be printed.

In addition, one of ordinary skill in the art at the time the invention was made would not have looked into Rzepkowski to modify the method of Fitzpatrick. Rzepkowski is concerned with scanning documents, as opposed to Fitzpatrick who is concerned with printing documents. A document to be scanned is already known to the user, who is only concerned with selecting the appropriate scanning parameters so that the scanned document has the desired size/orientation. In contrast, in a printing operation, the user wants to know the contents of the file before it is printed, so that he may choose to proceed with the printing or not.

The Examiner asserted that "scanning reads on printing document but in an electronic format". Scanning is an operation that results in an electronic file which may never be printed. In contrast, a printing operation results in the production of a hard copy document. This is the reason, one would not have looked into Rzepkowski to modify Fitzpatrick.

Claim 8 requires "when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed" The cited art fails to disclose or suggest this aspect of claim 8. There is nothing in the art of record which would have led one of ordinary skill to the invention of claim 8. There is clearly no prima facie case of obviousness in this respect.

(iii) Whether claim 4 is unpatentable under §103(a) over Fitzpatrick in view of
Rzepkowski and Hemenway

Claim 4 stands rejected under Section 103(a) as being allegedly unpatentable over Fitzpatrick in view of Rzepkowski and Hemenway. This Section 103(a) rejection is incorrect and should be reversed for at least the following reasons.

Claim 4 defines over the cited art, at least for the reasons set forth above in connection with claim 3 because claim 4 depends from claim 3.

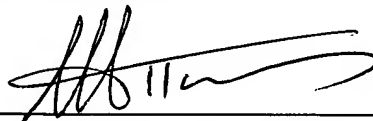
CONCLUSION

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

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(VIII) CLAIMS APPENDIX

1. A print control operation system comprising:

the print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions are displayed on said display picture in a recognizable display form when the file icon is not located over the print icon, and

wherein the print icon to which the file icon is dragged and dropped is an icon which limits on a specific function among print processing functions provided in a corresponding printer, and which issues a print command by a function which specifies the file icon for the printer when the file icon is dragged and dropped on the print icon, and wherein the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer.

2. A print control operation system using icons according to claim 1, wherein at a time point when a file icon of a file to be printed is superposed on said print icon, an outline of the print conditions preset in said print icon is displayed on said display picture.

3. A print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print conditions in said print icon are displayed on said display picture in a recognizable display form, and

wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon's associated file to be printed is displayed on said display picture.

4. A print control operation system using icons according to claim 3, wherein when a plurality of file icons of files to be printed are dragged and dropped on said print icon, these files are consecutively subject to print processing as a series of recorded matters.

5. A print control operation system using icons according to claim 3, wherein when a file icon of a file to be printed is dragged and dropped on said print icon, a window for setting print conditions of said print icon is opened.

6. A print control operation system using icons according to claim 3, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in said print icon.

7. A print control operation system using icons according to claim 6, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected from among printers in a stand-by state, based on print conditions set in said print icon.

8. A print control operation system using icons according to claim 6, wherein a printer to be used is set in said print icon as one of set conditions of said print icon,

a state of said printer is monitored in said print control operation system, and
when said printer is in such a state that said printer cannot execute processing set in said
print icon, said print icon is controlled so as not to be displayed.

9. (Allowed - Not on Appeal) A print control operation system using icons including a
display picture for displaying a print icon having predetermined print conditions and a file icon
of a file to be printed, print processing of said file being executed under the print conditions
predetermined in said print icon by dragging said file icon and dropping said file icon on said
print icon,

wherein said print control operation system is formed so as to create a print icon having
new print conditions set therein, when a predetermined plurality of print icons displayed on said
display screen and respectively having different print conditions are coupled.

10. A print control operation system using icons according to claim 1, wherein at a time
point when a file icon of a file to be printed is superposed on said print icon, a printing preview
of the file icon is displayed on said display picture.

11. The print control operation system of claim 3, wherein the printing preview allows a
user to view and confirm contents of a file to be printed without having to open the file on an
application.

(IX) **EVIDENCE APPENDIX**

None.

(X) **RELATED PROCEEDINGS APPENDIX**

None.